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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,179	07/19/2001	Michael Kahn	MATP-610US	9083
23122	7590	04/07/2004	EXAMINER	
RATNERPRESTIA P O BOX 980 VALLEY FORGE, PA 19482-0980			VENT, JAMIE J	
			ART UNIT	PAPER NUMBER
			2613	5
DATE MAILED: 04/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,179

Applicant(s)

KAHN, MICHAEL

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 5, 7, 8, 10, 11, 12, and 13 are rejected under 35 U.S.C. 102(b) as being unpatentable by Scott (US 4,625,080).

[claim 1]

In regard to Claim 1, Scott discloses a video recorder programming device comprising:

- Means for communicating between a user and said video recording programming device through a telephone connection (Figure 1);
- Means for storing audio messages transmitted by said user through said means for communicating (Figure 3 element 28 transmits stored audio message to the video recorder device);
- Means for receiving and storing recording parameter data transmitted by said user through said means for communicating (Figure 3 element 66 receives the transmitted data and stores the data); and,
- Means for starting a recording process by a video recorder responsive to the stored parameters (Figure 3 element 74 device for recording process).

[claim 3]

In regard to Claim 3, Scott discloses a device wherein the parameters include a channel number and a start time (Column 2 Lines 8-10), and the device further comprises a television receiver

and decoder including a television tuner for tuning to the channel specified by the channel number at a time equal to the start time to receive and decode a television signal corresponding to the parameters, whereby the video recorder records the decoded television signal (Figure 3 element 72 shows the tuner while Column 5 Lines 1-10 describe the process).

[claim 4]

In regard to Claim 4, Scott discloses a device further comprises a mass storage device and the means for the starting the recording process causes the decoded television signal to be stored in the mass storage device as the video recorder (Figure 3 element 66 shows the storage device while Column 4 Lines 48-55 describe the recording process).

[claim 5]

In regard to Claim 5, Scott discloses a means for storing audio messages comprises a telephone answering machines (Figure 3 element 28).

[claim 7]

In regard to Claim 7, Scott discloses a method of programming a video recorder device comprising:

- Enabling telephone communications between a user and a set top box (Figure 1);
- Transmitting audio data to the user to prompt the user to transmit audio programming data including start time data and one of stop time data and duration data (Column 3 Lines 13-20 describe audio data through the speaker regarding programming data);
- Receiving the audio programming data into the set top box through said telephone communications and converting the audio programming data into command data

for the video recording device (Column 4 lines 48-56 converting of the audio programming data into the programming data needed to command the recordings); and,

- Transmitting the command data to the video recording device (Figure 3 lines 70a, 70b, and 70c).

[claim 8]

In regard to Claim 8, Scott discloses a method wherein the set top box further includes telephone answering machine functionality and the method further comprises the step of receiving predetermined audio data to switch the set top box from the answering machine functionality prior to receiving the audio programming data (Column 2 Lines 34-37 states the answering machine “establishes” contact between the modem and the transmitter thereby switching the set top box from the answering machine to the video recorder prior to receiving the data).

[claim 10]

In regard to Claim 10, Scott discloses a method for including the step of storing the command data in the set top box (Figure 3 element 66 encompasses part of the set top box).

[claim 11]

In regard to Claim 11, Scott discloses a method wherein the step of transmitting audio data to the user includes steps of prompting the user to select between entering new programming data, deleting existing programming data and editing existing programming data and the step of receiving the audio programming data includes modifying the stored command data responsive to audio programming data received through the telephone communications (Column 3 Lines 12-20 state the transmitting of audio data to the user while Column 3 Lines 5-11 state the

programming data/audio data is prompted for the user to enter new data information including the beginning and ending times and channel number).

[claim 12]

In regard to Claim 12, Scott discloses a method of programming a video recorder comprising:

- Detecting an incoming telephone call by a set top box containing an automated answering machine (Figure 3);
- Enabling telephone communication between user and set top box (Figure 1);
- Transmitting a message from automated answering machine to user (Figure 3)
- Detecting a programming signal transmitted by said user through said telephonic communication to said automated answering machine (Figure 3 as well as detection described in Column 2 Lines 34-37);
- Receiving programming data into said automated answering machine, said programming data being transmitted by said user through said telephone communication and including start time and at least one of stop time data and duration (Figure 3 shows the receiving of the data while Column 4 lines 48 describe the method); and
- Transmitting said programming data and a control code from said automated answering machine to said video recorder to enable a recording function of said video recorder (Figure 3 elements 70a , 70b, and 70c).

[claim 13]

In regard to Claim 13, Scott discloses the storing of said programming data into a data storage device (Figure 3 element 66 stores the data).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (US 4,625,080) in view of Shimada et al (US Re 35,343).

[claims 2, 9, & 14]

In regard to Claims 2, 9, and 14 Scott discloses a video recorder programming device comprising:

- means for starting the recording process of transmitting a command to the video recorder causing the video recorder to enter a programming mode, transmits the parameters to the video recorder as the program and transmits a command to the video recorder to leave the programming mode (Figure 3 elements 70a, 70b, and 70c as well as Column 4 lines 20-35 describe the transmitting of the command signal) ;
- means of transmitting the command data to the video recording device (column 4 Lines 20-35); however, lacks an infrared signal transmitter to conversion of the command signal.

Shimada et al discloses a video programming system wherein the "commander generally transmits a control command toward a control command receiver provided on the front panel. In

practice the control command is in the form of an infrared light beam encoded with control command data" (column 7 lines 2-6).

Therefore, it would be obvious to one skilled in the art at the time of the invention to use the remote video recorder programming apparatus that operates over telephone lines, as disclosed by Scott, and incorporate the video recorder device transmit the control signal via infrared signal transmitter, as disclosed by Shimada et al. Incorporating the infrared signal transmitter would allow for the system to be more versatile if for example the system were to use a wireless phone the use of infrared signal allow for transmitting of the control data to the set top box.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (US 4,625,080) in view of Yuen et al (US 6,430,359).

[claim 6]

In regard to Claim 6, Scott discloses a means for switching the device between operating as telephone answering machine and as the video recorder (Column 3 Lines 24-26 describe how contact is made by the answering machine) however, lacks the means to be responsive to a predetermined dual-tone multi-frequency (DTMF) code. Yuen et al discloses an apparatus for compressed codes for television program record scheduling which uses a predetermined dual-tone multi-frequency as seen in Figure 43.

Therefore, it would be obvious to one skilled in the art at the time of the invention to use the remote video recorder programming apparatus that operates over telephone lines, as disclosed by Scott, and incorporate the use of predetermined dual-tone multi-frequency (DTMF) code, as disclosed by Yuen et al. By using the dual-tone multi-frequency (DTMF) will allow for

the remote video recorder to have a more secure means of switching the device between operating as the telephone answering machine and video recorder.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Imadea (US 5969749); and
- Williams et al (US 5977964)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number 703.305.0378. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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